

action further states that, because the claims of the '930 application use the term "comprising," thereby allowing for additional method steps to be present, that somehow makes it obvious to include the particular steps presently claimed: "another administration step (i.e., administration of nitric oxide) . . . would be obvious since nitric oxide is a highly reactive free radical compound produced by many cells of the body that relaxes vascular smooth muscle (see the background of the instant invention)."

The Office action fails to identify any prior art motivation to combine administration of carbon monoxide and administration of nitric oxide in methods of organ transplantation. The Office action has not indicated, and Applicants are not aware of any reason, why the fact that nitric oxide is "a free radical compound produced by many cells of the body that relaxes vascular smooth muscle" (the sole basis for the rejection cited in the Office action) provides any suggestion of its use for organ transplantation, either alone or in combination with administration of carbon monoxide. Nor can the presence of the open term "comprising" in the '930 claims be taken as providing the necessary motivation. The Examiner has given no plausible rationale for combining administration of nitric oxide and administration of carbon monoxide in methods of organ transplantation.

The mere fact that administration of nitric oxide can be combined with administration of carbon monoxide or is within the capabilities of one of skill in the art to be combined with administration of carbon monoxide is, of course, not sufficient to establish obviousness. Some suggestion of the desirability of the combination must be found within the art. As it stands, the obviousness-type double patenting rejection appears to rely on nothing more than improper hindsight reasoning based on Applicants' own disclosure.

It is true that the presently claimed methods are encompassed by the broader claims of the '930 application. However, as the Examiner is no doubt aware, this alone is not enough to establish obviousness—indeed, if this were the standard for obviousness, one could never patent a new method if one of the steps of the method was known in the art. Furthermore, the Examiner has indicated at page 5 of the Office action that "the elected invention is distinguished over the prior art of record because the prior art neither anticipates nor renders obvious methods of

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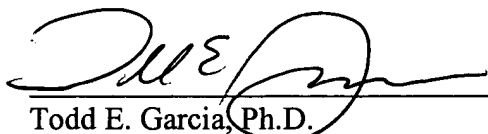
transplantation as set forth in claims 16-20 wherein nitric oxide is administered in combination with carbon monoxide as set forth in the method steps of the claims." If the present claims are not obvious over the art, it would be logically impossible for the present claims to be obvious over the claims of the '930 application.

Applicants submit that the Office action fails to present a sufficient case to support an obviousness-type double patenting rejection. Therefore, Applicants request that the Examiner withdraw the rejection and acknowledge the allowability of the currently pending claims.

Enclosed is a Petition for Extension of Time and the required fee. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney Docket No. 13681-012001.

Respectfully submitted,

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